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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/680,980	10/08/2003	Werner Knebel	5005.1061	6488
7278	7590	02/06/2007		
DARBY & DARBY P.C. P. O. BOX 5257 NEW YORK, NY 10150-5257			EXAMINER FINEMAN, LEE A	
			ART UNIT	PAPER NUMBER
			2872	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		02/06/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/680,980	Applicant(s) KNEBEL, WERNER	
	Examiner Lee Fineman	Art Unit 2872	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 November 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 7-18 is/are pending in the application.
- 4a) Of the above claim(s) 3-5, 7 and 12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 10, 11, 13 and 17 is/are rejected.
- 7) ☒ Claim(s) 2, 8, 9, 14-16 and 18 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office Action is in response to an amendment filed 2 November 2206 in which claim 1 was amended. Claims 1-5 and 7-18 are pending of which claims 3-5, 7 and 12 are withdrawn.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 10-11 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Hoffmann, US 2002/0109101 A1.

Regarding claims 1 and 17, Hoffmann discloses in fig 2 a confocal scanning microscope comprising: a light source (17) that emits an illuminating light beam (19), for illumination of a sample (39), that extends along an illumination beam path (41) and can be guided over the sample (39) using a beam deflection device (31); a detector (45) that receives detection light (43), proceeding from the sample (39), that extends along a detection beam path (43); a light source (21) that emits a manipulating light beam (23, in at least so far as it manipulates the overall emission of the sample); and a mirror (27; incorrectly labeled 31 in fig. 2) which can be introduced in guided fashion into the illumination beam and detection beam paths at a position in the illumination and detection beam paths(fig. 2, at least in so far as it was guided into place during assembly), the detection beam path having a direction opposite to a direction of the

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illumination beam path at the position (fig. 2), whereby the mirror directs the manipulating light beam via the beam deflection device onto the sample (fig. 2); and wherein the manipulating light beam (from 21) can be guided over the sample (39) using the beam deflection device (31).

Regarding claims 10-11, Hoffman further discloses wherein the illuminating light beam (19) and the manipulating light beam (23) can be guided on a scanning track (by 31) over and/or through the sample (39).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hoffman in view of Knebel et al. US 2002/0020800 A1.

Regarding claim 13, Hoffman discloses the claimed invention except for wherein the scanning track is largely meander-shaped or sinusoidal. Knebel et al. teaches a confocal scanning microscope (page 5, section [0056]) comprising a light source (3 and 4) that emits an illuminating light beam (on 5), for illumination of a sample (1), that extends along an illumination beam path (5) and can be guided over and/or through the sample (1) using a beam deflection device (12); a detector (6) that receives detection light (on 7), proceeding from the sample (1), that extends along a detection beam path (7); and a light source (8) that emits a manipulating light beam (on 9) wherein the illuminating light beam (on 5) can be guided on a

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scanning track (by 12) over and/or through the sample (1); and wherein the scanning track is largely meander-shaped or sinusoidal (see fig. 4). It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the scanning track of Hoffmann be sinusoidal as taught by Knebel et al. to provide a detailed three-dimensional visualization of the sample (Knebel, page 2, section [0023]).

Allowable Subject Matter

6. Claims 2, 8-9, 14-16 and 18 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

7. The following is a statement of reasons for the indication of allowable subject matter:

Claims 2, 8-9 and 18 have allowable subject matter over the prior art for at least the reason that the prior art fails to teach and/or suggest “wherein the mirror is a hinged mirror,” “wherein the mirror is at least partially transparent to the illuminating light beam,” or “wherein the mirror can be put in a neutral position out of the illuminating beam path” as set forth in the claimed combination.

Hoffman discloses a confocal scanning microscope comprising: an illuminating light source (17), a beam deflection device (31); a detector (45); a manipulating light source (21) and a mirror (27) as set forth above but does not have wherein the mirror is a hinged mirror, wherein the mirror is at least partially transparent to the illuminating light beam, or wherein the mirror

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can be put in a neutral position out of the illuminating beam path as claimed. It is also noted that a 103 rejection is not appropriate, as it would prevent the microscope from functioning correctly.

Claims 14-16 have allowable subject matter over the prior art for at least the reason that the prior art fails to teach and/or suggest wherein the manipulating light beam bleaches or cuts the sample or acts as an optical tweezers as set forth in the claimed combination.

As stated above Hoffman discloses a confocal scanning microscope, but the manipulating light beam do not bleach or cut the sample or act as an optical tweezers as claimed. Again it is noted that a 103 rejection is not appropriate, as it would prevent the microscope from functioning correctly.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lee Fineman whose telephone number is (571) 272-2313. The examiner can normally be reached on Monday - Friday 7:30 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephone Allen can be reached on (571) 272-2434. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



LAF

23 January 2007


MARK A. ROBINSON
PRIMARY EXAMINER